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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/627,253	07/28/2000	John R. Mason	1322/40/2	2388
25297	7590	05/19/2004	EXAMINER	
JENKINS & WILSON, PA 3100 TOWER BLVD SUITE 1400 DURHAM, NC 27707			NGUYEN, TOAN D	
			ART UNIT	PAPER NUMBER
			2665	22

DATE MAILED: 05/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/627,253	MASON ET AL.
	Examiner Toan D Nguyen	Art Unit 2665

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) Responsive to communication(s) filed on 10 February 2004.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) Claim(s) 1-78 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) 35-41,73 and 74 is/are allowed.

6) Claim(s) 1-10,22-34,42-50,61-66,69-72,75 and 76 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) 11-21,51-60,67,68,77 and 78 are subject to restriction and/or election requirement.

**Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 18 August 2000 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a)  The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.

4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, 22-50, 61-66 and 69-76 drawn to a method for updating presence information regarding a target end user in a presence database based on information derived from a telephony-related action, classified in class 370, subclass 352.
  - II. Claims 11-21, 51-60, 67-68 and 77-78 drawn to a method for processing a query to a presence server database, classified in class 707, subclass 3.
2. The inventions are distinct, each from the other because:
3. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention I has separate utility such as updating presence information regarding a target end user in a presence database based on information derived from a telephony-related action, and invention II also has separate utility such as processing a query to a presence server database. See MPEP § 806.05(d).
4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
5. During a telephone conversation with Mr. Gregory A. Hunt on April 30, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-10, 22-50, 61-66 and 69-76. Affirmation of this election must be made by applicant in replying

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to this Office action. Claims 11-21, 51-60, 67-68 and 77-78 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 1, 4, 6, 10, 22-23, 25, 28-33, 42, 45-47, 61-65, 69, 71 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sladek et al. (U.S. 6,718,178 B1) in view of Pirkola et al. (U.S. 6,611,516 B1).

For claims 1 and 10, Sladek et al. disclose automatic in-line messaging system, comprising:

- (a) receiving a signaling system seven (SS7) message in response to a telephony-related action performed by a target end user (figure 3, Reference 12) to which other end users (figure 3, Reference 14) are subscribed in a presence database (Reference 44) (figure 9, col. 14 lines 37-42);
- (c) in response to determining that presence registration processing is required for the target end user (Reference 12), automatically generating a presence registration message including presence information usable by a presence server (figure 9, Reference 42) for automatically indicating to the end users a communication medium for contacting the target end user (Reference 12) using a text messaging protocol and indicating that the target end user is currently available to receive text message protocol messages via the communications medium (col. 15 lines 2-7); and
- (d) transmitting the presence registration message to the presence server over an IP network (col. 7 lines 10-12).

However, Sladek et al. does not disclose:

- (b) determining, based on the SS7 message, whether presence registration processing is required for the target end user.

In an analogous art, Pirkola et al. disclose:

- (b) determining, based on the SS7 message, whether presence registration processing is required for the target end user (col. 13 lines 8-13).

One skilled in the art would have recognized presence registration processing is required for the target end user to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the presence registration processing is required for the target end user as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to constantly maintain updated status and location information in the subscriber's Home Function (col. 13 lines 2-5).

For claims 4, 28 and 45, Sladek et al. disclose the SS7 message is a transaction capabilities application part (TCAP) message containing presence information for the end user (col. 2 line 36-38).

For claim 5, Sladek et al. disclose automatic in-line messaging system, comprising:

- (a) receiving a signaling system seven 7 (SS7) message in response to a telephony-related action performed by a target end user (figure 3, Reference 12) (figure 9, col. 14 lines 37-42);
- (b) intercepting the SS7 message, extracting information from the SS7 message (figure 9, col. 14 lines 37-42).

However, Sladek et al. does not disclose wherein the telephony-related action is the activation or change in location of a mobile telephone handset and the SS7 message is a message for updating the status of the target end user in at least one of a home location register (HLR) and a visitor location register (VLR); and using the information extracted from the SS7 message to update presence protocol information for the target end user in a presence database.

In an analogous art, Pirkola et al. disclose wherein the telephony-related action is the activation or change in location of a mobile telephone handset (col. 3 lines 1-3) and the SS7

message is a message (col. 8 lines 46-51) for updating the status of the target end user in at least one of a home location register (HLR) and a visitor location register (VLR) (col. 3 lines 1-5); and using the information extracted from the SS7 message to update presence protocol information for the target end user in a presence database (col. 3 lines 1-5).

One skilled in the art would have recognized change in location of a mobile telephone handset to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the change in location of a mobile telephone handset as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to update the subscriber's record in the HLR (col. 3 lines 4-5).

For claims 6 and 25, Sladek et al. disclose wherein automatically generating a presence registration message includes automatically generating a presence protocol message (figure 8, col. 13 lines 40-41 and col. 13 lines 49-50).

For claim 22 and 30-32, Sladek et al. disclose automatic in-line messaging system, comprising:

- (a) a communication module for receiving an SS7 message relating to a target end user (figure 3, Reference 12) to which other end users (figure 3, Reference 14) are subscribed in a presence database (Reference 44) (figure 9, col. 14 lines 37-42); and
- (b) a presence server (Reference 42) message generator for, if the communication module determines that presence registration processing is required, for receiving a copy of the SS7 message and for automatically generating a presence registration message including presence information being usable by a presence server (Reference 42) for automatically indicating to the end users subscribed to the target end user a communication medium for

contacting the target end user and the fact that the target end user is currently available to receive text messaging protocol messages via the communications medium (col. 15 lines 2-7).

However, Sladek et al. does not disclose determining whether presence registration processing is required for the SS7 message. In an analogous art, Pirkola et al. disclose determining whether presence registration processing is required for the SS7 message (col. 13 lines 8-13).

Sladek et al. disclose a presence server database operatively associated with the presence server message generator (figure 9, col. 14 lines 37-42) and Pirkola et al. disclose updating the presence information in response to the presence-server-compatible message (as set forth in claims 30-32).

One skilled in the art would have recognized presence registration processing is required for the SS7 message to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the presence registration processing is required for the SS7 message as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to constantly maintain updated status and location information in the subscriber's Home Function (col. 13 lines 2-5).

For claim 23, Sladek et al. disclose an advanced database communication module for encapsulating the presence registration message in an IP packet and transmitting the IP packet to a presence server over an IP network (col. 7 lines 11-12 and col. 16 lines 59-66).

For claim 29, Sladek et al. disclose automatic in-line messaging system, comprising:

(a) a communication module for receiving an SS7 message from an SS7 network (figure 9, col. 14 lines 37-42);

(b) a presence server message generator (figure 9, Reference 42) for generating, based on the SS7 message, the presence information including text messaging protocol contact and availability information regarding the target end user that a presence server (Reference 42) automatically sends to end users (reference 14) subscribed to the target end user (Reference 12) in a presence database (Reference 44), wherein the SS7 message is a message from a mobile switching center (MCS) (col. 15 lines 2-7).

Sladek et al. disclose a presence-server-compatible message (figure 9, Reference 42). However, Sladek et al. does not disclose updating presence information regarding the target end user managed by a presence server. In an analogous art, Pirkola et al. disclose updating presence information regarding the target end user managed by a presence server (col. 2 lines 62-65).

One skilled in the art would have recognized updating presence information to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the updating presence information as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to update the subscriber's record in the HLR (col. 3 lines 4-5).

For claim 33, Sladek et al. disclose wherein the presence server message generator is adapted to receive presence queries, forward the presence queries to a presence server database, and receive responses from the presence server database (figure 8, col. 14 lines 9-17).

For claims 42 and 46-47, Sladek et al. disclose automatic in-line messaging system, comprising:

- (a) receiving a signaling system seven (SS7) message in response to a telephony-related action performed by a target end user (figure 3, Reference 12) (figure 9, col. 14 lines 37-42);
- (b) in response to receiving the SS7 (SS7) message, formulating an internet protocol (IP) message for presence information regarding the target end user (figure 10, Reference 68) managed by a presence server (Reference 76), the presence information including information usable by the presence server (Reference 76) for automatically indicating to end users subscribed to the target end user (Reference 68) in a presence server database a medium for communicating with the target end user via a text messaging protocol (col. 17 lines 6-10); and
- (c) transmitting the IP message to the presence server over an IP network (col. 7 lines 10-12).

However, Sladek et al. does not disclose updating presence information regarding the target end user managed by a presence server. In an analogous art, Pirkola et al. disclose updating presence information regarding the target end user managed by a presence server (col. 2 lines 62-65). One skilled in the art would have recognized updating presence information to use the teachings of Pirkola et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the updating presence information as taught by Pirkola et al. in Sladek et al.'s system with the motivation being to update the subscriber's record in the HLR (col. 3 lines 4-5).

For claims 61-64, Sladek et al. disclose routing the SS7 message to its intended destination (figure 9, col. 14 lines 37-40 and col. 15 lines 4-7).

For claims 65 and 69, Sladek et al. disclose wherein steps (a)-(d) are performed at an SS7 signal transfer point capable of transferring SS7 signaling messages between SS7 signaling links (col. 2 lines 36-40 and col. 3 lines 49-51).

For claim 71, Sladek et al. disclose wherein steps (a)-(d) are performed at an SS7 signal transfer point capable of transferring SS7 signaling messages between SS7 signaling links (col. 2 lines 36-40 and col. 3 lines 49-51).

For claim 75, Sladek et al. disclose wherein steps (a)-(d) are performed at an SS7 signal transfer point capable of transferring SS7 signaling messages between SS7 signaling links (col. 2 lines 36-40 and col. 3 lines 49-51).

10. Claims 2-3, 27 and 43-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sladek et al. (U.S. 6,718,178 B1) in view of Pirkola et al. (U.S. 6,611,516 B1) further in view of Christie, IV (U.S. 6,430,176 B1).

For claims 2-3, 27 and 43-44, Sladek et al. in view of Pirkola et al. does not disclose a PSTN telephone to initiate a call from the target end user to the called party telephone number and the signaling system seven message is an IAM message. In an analogous art, Christie, IV discloses disclose a PSTN telephone to initiate a call from the target end user to the called party telephone number (col. 3 lines 22-24) and the signaling system seven message is an IAM message col. 6 lines 12-16 as set forth in claim 2 and 43).

Christie, IV discloses the telephony-related action includes entering DTMF digits using a PSTN telephone handset after a call has been established, the DTMF digits forming a code for instructing an end office to formulate the SS7 message (col. 6 lines 4-7 as set forth in claims 3

and 44); wherein the SS7 message is an ISDN user part (ISUP) message (col. 6 lines 8-9 as set forth in claim 27).

One skilled in the art would have recognized a PSTN telephone to use the teachings of Christie, IV in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time invention, to use the PSTN telephone as taught by Christie, IV in Sladek et al.'s system with the motivation being to establish simultaneous voice and data (multimedia) communications between such telecommunications infrastructures (col. 1 lines 9-11).

11. Claims 7-9, 24, 26, 34, 48-50, 66, 70, 72 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sladek et al. (U.S. 6,718,178 B1) in view of Pirkola et al. (U.S. 6,611,516 B1) further in view of Gudjonsson et al. (U.S. 6,564,261 B1).

For claims 7-9, 24, 26, 34, 48-50, 66, 70, 72 and 76, Sladek et al. in view of Pirkola et al. does not disclose a session initiation protocol (SIP) message. In an analogous art, Gudjonsson et al. disclose a session initiation protocol (SIP) message (col. 9 line 18 as set forth in claims 7, 24 and 48). Gudjonsson et al. disclose an instant messaging and presence protocol (IMPP) message (col. 2 line 22 as set forth in claims 8, 26, 49, 66, 70, 72 and 76); and sending a second message to an accounting and billing system (col. 11 lines 10-15 as set forth in claims 9, 34 and 50).

One skilled in the art would have recognized a session initiation protocol (SIP) message to use the teachings of Gudjonsson et al. in the system of Sladek et al. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention, to use the session initiation protocol (SIP) message as taught by Gudjonsson et al. in Sladek et al.'s system with the motivation being to establish a communication with another user (col. 9 lines 10-17).

***Allowable Subject Matter***

12. Claims 35-41 and 73-74 are allowed.
13. The following is an examiner's statement of reasons for allowance:

Regarding claims 35, the prior art fails to teach a combination of the steps of:

(b) a presence server message processor operably associated with the advanced database communications module for forwarding the presence-server-compatible message to a presence server for determining the presence information, wherein the presence server stores the presence information for the first end user, and subscription information indicating a second end user subscribed to automatically receive presence information regarding the first end user and sends a response to the presence-server-compatible message to the second end user, thereby informing the second end user of the appropriate communications medium for contacting the first end user using text messaging protocol communications and whether the first end user is currently available to receive text messaging protocol message via the communication medium, in the specific combination as recited in the claim.

***Response to Arguments***

14. Applicant's arguments with respect to claims 1-10, 22-50, 61-66 and 69-76 have been considered but are moot in view of the new ground(s) of rejection.

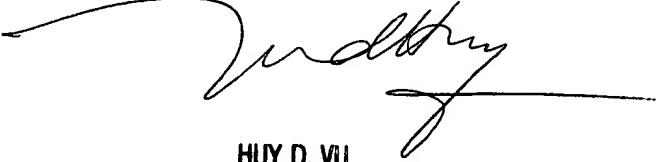
***Contact Information***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Toan D Nguyen whose telephone number is 703-305-0140. The examiner can normally be reached on Monday- Friday (7:00AM-4:30PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Huy Vu can be reached on 703-308-6602. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-9600.

  
T.N.

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